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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/146,069 | 09/02/1998 | TAKEHIRO YOSHIDA | 1232-4467 | 6726 |
| 27123 | 7590 | 12/14/2004 | EXAMINER | |
| MORGAN & FINNEGANT, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101 | | | POKRZYWA, JOSEPH R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2622 | |

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/146,069 | YOSHIDA, TAKEHIRO | |
| | Examiner | Art Unit | |
| | Joseph R. Pokrzywa | 2622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 July 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-16, 18-20 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 12-16, 18-20 and 26-29 is/are allowed.
- 6) Claim(s) 30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/18/04 has been entered.

Response to Corrected Amendment

2. Applicant's corrected amendment was received on 7/23/04, and has been entered and made of record. Currently, **claims 12-16, 18-20, and 26-30** are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 30** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291, cited in the Office action dated 1/29/04) in view of Wegner *et al.* (U.S. Patent Number 5,712,907).

Regarding *claim 30*, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) capable of facsimile communication through the Internet by dial-up connection (see abstract, and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), comprising an Internet facsimile unit (mail editor 24, column 4, line 63-column 5, line 60) configured to execute a facsimile communication from a station A to a station B via the Internet (see abstract, Fig 3, column 5, lines 28 through 60, and column 7, lines 11 through 60, being steps S9-S13 in Fig. 6), and a notification unit (modem 10) configured to notify the station B via the PSTN (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) that a facsimile has been sent via the Internet (see Fig. 11, column 7, lines 51-55) and notify the station B via the PSTN of description information of the facsimile, when the facsimile communication has been executed by the Internet facsimile unit (see Fig. 11).

However, Ishibashi fails to teach of a control unit of, when the cost of the facsimile communication via the Internet and the notification via the PSTN from the station A to the station B is more than a predetermined value, transmitting all the facsimile information from the station A to the station B through the PSTN without performing communication via the Internet by the Internet facsimile unit.

Wegner discloses a communication apparatus (network node 87 or 88) capable of facsimile communication through the Internet by dial-up connection (column 2, lines 46-63), comprising an Internet facsimile unit configured to execute a facsimile communication from a station A to a station B via the Internet (column 8, lines column 13, line 64-column 14, line 11), a notification unit configured to notify the station B via the PSTN (column 14, lines 58-67), and a control unit of, when the cost of the facsimile communication via the Internet and the

notification via the PSTN from the station A to the station B is more than a predetermined value (column 10, line 66-column 11, line 34), transmitting all the facsimile information from the station A to the station B through the PSTN without performing communication via the Internet by the Internet facsimile unit (column 10, line 66-column 13, line 49).

Ishibashi & Wegner are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages over the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Wegner's least cost routing teachings within the system of Ishibashi. The suggestion/motivation for doing so would have been that Ishibashi's system would become more economical with the inclusion of Wegner's teachings, since the determined route would be determined based on the most cost effective route, as recognized by Wegner in column 11, lines 2-34. Therefore, it would have been obvious to combine the teachings of Wegner with the system of Ishibashi to obtain the invention as specified in claim 30.

Allowable Subject Matter

5. **Claims 12-16, 18-20, and 26-29** are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claims 12, and 18-20**, in the examiner's opinion, it would not have been obvious to one of ordinary skill in the art to have the systems, as claimed, include the features of notifying the station B via the PSTN of report information representing that a facsimile has been sent to the station B through the Internet and description information of the facsimile when the facsimile communication has been executed and causing the notification not to be performed

when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp

